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#### D. REMARKS

##### *Claim Rejections – 35 U.S.C. § 103*

1.2. Claims 1-35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over US Patent 5,903,642 to Shwartz et al. (hereafter Schwartz) in view of US Patent 6,195,426 to Bolduc et al. (hereafter Bolduc). The Examiner carries the burden of proving a prima facie case of obviousness. Because the Examiner does not carry the burden of proving a prima facie case of obviousness for claims 1-35, the rejection should be withdrawn and the claims allowed.

##### **Claim 1**

Regarding claim 1, the Examiner relies on Schwartz as teaching the first element of “monitoring a plurality of characteristics of an on hold system.” In particular, the Examiner notes that Schwartz col. 4, line 38 teaches a method where “a new call is positioned on a queue and a calculation is reported to the caller as to the approximate time the caller can expect to wait to be connected.” [Office Action, p. 2] The Examiner specifies that Schwartz does not, however, teach the second element of “responsive to a selection by a caller of a format for publishing said plurality of characteristics, transferring said plurality of characteristics to said caller in said selected format.” [Office Action, p. 2] Instead, the Examiner relies on Bolduc col. 6, line 58 to teach this second element in an attempt to show that the combined prior art references teach or suggest all the claim limitations. [Office Action, p. 2]

Bolduc col. 6, lines 56-67 and col. 7 lines 1-5 read as follows:

“The queue server 410 may prompt the customer to enter a textual description of his question. The customer may enter the information via a forms based interface that supplies specific information about the customer’s product, its environment, the customer’s problem, etc.; the question alternatively may be posed as a free form message, such as by e-mail. In addition to prioritizing messages based on customer indicia, the queue server 410 also may prioritize the messages by

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performing a keyword search of messages based on the description. Messages that coincide with identified keywords are given an enhanced priority.

As with the embodiment of Fig. 1, the database 430 may associate the customer with more than one field of information. Optionally, the queue: server 410 may identify the relevant fields and prompt the customer to select among them.”

In establishing a *prima facie* case of obviousness under 103(a), the combined prior art references must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.3d 488, 20 USPQ2d 1438 (Fed Cir. 1991). Applicants respectfully propose that Schwartz in view of Bolduc does not teach the method of claim 1 as described by the Examiner and therefore *prima facie* obviousness is not shown. The Examiner interprets Bolduc col. 6, line 58 (expanded above by Applicants to include information referenced by the Examiner in lines 56-67 and col. 7, lines 1-5) as a method in which “the customized product information is compiled and delivered by a queue server (410) based on information input by the customer (i.e. caller) via a forms based interface. The queue server (410) accomplishes this by identifying relevant fields produced by a keyword search on information entered by the customer (i.e. caller) and prompts the customer (i.e. caller) to select among those relevant fields.” [Office Action, p. 2-3] The Examiner states that this interpretation of Bolduc teaches the element of “responsive to a selection by a caller of a format for publishing said plurality of characteristics, transferring said plurality of characteristics to said caller in said selected format.” [Office Action, p. 2]

Applicants note that Bolduc teaches that when required, the customer is selecting among relevant fields of products or services. [Bolduc col. 3, lines 50-51] Further, Applicants note that Bolduc teaches that once the customer selects a relevant field, then the messages related to that field are specified, prioritized, and played to the customer in the order of priority. [Bolduc Fig. 2 and Fig. 4] Applicants respectfully propose that the process described in Bolduc is one of filtering and prioritizing a selection of pre-recorded messages based on a user designation of the type of product or service the caller is inquiring about. The present invention process is not one of filtering and prioritizing, but is one of controlling the actual output format of dynamically

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monitored characteristics based on a user designation of a formatting preference. More generally, in the present invention, the caller is not specifying the subject matter of information, but instead is specifying how the caller would like the information to be output. Thus, even if the information filtered and prioritized in Bolduc includes the characteristics of the on hold system, there is no teaching in Bolduc that a user further enters a preference for the output format of the characteristics or a system that controls output of the characteristics to the caller according to a caller specified format. As described in the examination of claim 4, Bolduc does describe multiple types of formats in which output files for pre-recorded messages may be stored [Bolduc col. 6, lines 22-24]. However, a mere description of storing formatted files, does not teach the method of selecting one of the formats based on a user specified input and transferring the information to the user in that format. Therefore, because the combined prior art references do not teach or suggest all the claimed invention, Applicant respectfully requests allowance of claim 1.

### Claims 2-7

Regarding claims 2-7, Applicants respectfully propose that because the Examiner did not establish prima facie obviousness for the independent claim upon which these dependent claims rely, then these dependent claims are also not obvious and should be allowed. Specifically, however, Applicants respectfully propose that even if prima facie obviousness were established for the independent claims, prima facie obviousness is not established in claim 5.

### Claim 5

Specifically regarding claim 5, the Examiner relies on Bolduc col. 7, line 23 as teaching "transferring said plurality of characteristics in said format to an interface specified by said caller." [Office Action, p. 4] Bolduc col. 7, lines 23-26 read as follows: "In addition to computer telephony, the customer and attendant may communicate through conventional e-mail or chat messaging, or the attendant simply may place a standard telephone call to the customer." The Examiner interprets this to mean that "the customized information (i.e. plurality of characteristics) may be delivered to the caller through multiple means including conventional e-mail, chat messaging, computer telephony, or standard telephony." [Office Action, p. 4]

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In establishing a *prima facie* case of obviousness under 103(a), the claimed invention must be considered as a whole when ascertaining differences between the prior art and the claims.

*Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5. Delineating the invention as a whole requires examination of not only the subject matter which is literally recited in the claim in question, but also those properties of the subject matter which are inherent in the subject matter and are disclosed in the specification. M.P.E.P. 2141.03; *In re Antonie*, 559 F.2d 618, 620.

Applicants respectfully propose that the Examiner does not establish *prima facie* obviousness because “conventional e-mail, chat messaging, computer telephony, or standard telephony” do not describe the “interface” of the claimed invention and thus the claimed invention as a whole is not considered when ascertaining the differences between the prior art and the claims.

First, in referring to “conventional e-mail, chat messaging, computer telephony, or standard telephony” Bolduc describes different mediums of communication, but does not describe the method of the present invention of allowing a user to specify the interface to which one of those types of mediums of communication should be employed to deliver the characteristics.

Second, the properties of an “interface” and the selection of an “interface” are described in detail in the specification of the present invention and should be referred to in considering the claimed invention as a whole. For example, the specification describes that “in offering the caller a menu of available options for receiving call hold queue information, the caller is offered the choice of the interface at which to receive the call hold queue information from on hold system 12.”

(Brown et al. p 12) Such interfaces may include a telephone, computer, digital text supporting device, or network server. Further, in the specification, “the on hold system 12 may publish call hold queue information to multiple interfaces” including interfaces other than the one used to place the call and interfaces outside the on hold system network (Brown et al. p 12). Bolduc describes a single terminal 30 through which a caller places a call and through which information may be received by a caller in different formats, but Bolduc does not describe

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allowing the caller to select to have information published to interfaces other than the one used to place the call, which is an advantage of the present invention.

Therefore, because an "interface" and the process of allowing a caller to select which "interface" to publish characteristics are not taught in Bolduc when viewed through the specification, the Examiner does not establish *prima facie* obviousness and allowance is respectfully requested.

#### **Claim 19**

Regarding claim 19, the Examiner refers to the discussion of Schwartz in view of Bolduc as applied to claims 1 and 5. Applicants refer to the discussion in this paper of claims 1 and 5 and respectfully propose that because the Examiner does not establish *prima facie* obviousness for claims 1 and 5, then related claim 19 is also not obvious and should be allowed.

#### **Claims 20-24**

Regarding claims 20-24, Applicants respectfully propose that because the Examiner does not establish *prima facie* obviousness for the independent claim 19 upon which these dependent claims rely, then these dependent claims are also not obvious and should be allowed.

Specifically, however, Applicants respectfully propose that even if *prima facie* obviousness were established for the independent claim, *prima facie* obviousness is not established in claim 22.

#### **Claim 22**

Specifically referring to claim 22, the Examiner relies on Bolduc col. 6, line 15 as teaching the claim which includes the following elements: "outputting a call tracking number and network address to the caller" and "responsive to detecting said call tracking number entered through a caller accessible interface accessing said network address, transferring said plurality of characteristics to said caller accessible interface." Bolduc col. 6, lines 15-19 reads as follows: "The queue server 410 is provided with a database 430 that associates customer identifiers with products supported by the queue. The identifiers may be the customer's network address, supplied automatically by the network 300, or a log or ID or an e-mail address, which may be supplied by the customer."

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In establishing a prima facie case of obviousness under 103(a), the claimed invention must be considered as a whole when ascertaining differences between the prior art and the claims.

*Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5. Delineating the invention as a whole requires examination of not only the subject matter which is literally recited in the claim in question, but also those properties of the subject matter which are inherent in the subject matter and are disclosed in the specification. M.P.E.P. 2141.03; *In re Antonie*, 559 F.2d 618, 620.

Applicants respectfully propose that the Examiner does not establish prima facie obviousness because the Examiner's interpretation of "caller accessible interface" does not fully describe the claimed invention and thus the claimed invention as a whole is not considered when ascertaining the differences between the prior art and the claims.

First, the specification describes that "on hold system 12 may publish call hold queue information to caller accessible interfaces 14a-14n, which are *independent* of the device utilized by the caller to place the call." (Brown et al p 12, emphasis added). While the caller accessible system described in claim 22 and the terminal 30 of Bolduc both access the call queue, they are distinguishable. Terminal 30 in Bolduc is the conduit through which both the call is placed and information is returned to the caller. In the present invention, a tracking number and network address are provided to the caller waiting in a call hold queue. Then separately, through the "caller accessible interface", the caller accesses the characteristics of the queue via the "caller accessible interface".

Second, the specification describes the hold queue system as providing "output of the call tracking number and a web or other network address for the caller to access. To access the call hold queue information, the caller utilizes a caller accessible interface, such as a personal computer system with a network connection, to access a web or other network page at the address and enters the call tracking number." (Brown et al. p. 14) The system of Bolduc describes a queue server (410) that receives phone calls and looks up an identifier in database (430) to determine the type of product or service the caller is registered for. [Bolduc col. 6, lines 12-14] Docket # AUS920010945US1

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15-19 ] Bolduc does not describe the claimed invention of outputting a call tracking number and network address to a caller that the caller can then use from a system independent of the one used to place the call to access the current call queue characteristics.

Therefore, because the “caller accessible interface” and the process of outputting a call tracking number and network address to a caller for accessing the call hold queue characteristics via the “caller accessible interface” are not taught in Bolduc when viewed through the specification, the Examiner does not establish *prima facie* obviousness and allowance is respectfully requested.

3. Claims 8, 9, 10, 11, 12, 13, and 14 stand rejected as apparatus claims that correspond directly to method claims 1, 2, 3, 4, 5, 6 and 7 respectively, and therefore, are rejected under the same rationale. Applicants respectfully propose that the Examiner does not establish *prima facie* obviousness for claims 1, 2, 3, 4, 5, 6 and 7, and therefore corresponding apparatus claims 8, 9, 10, 11, 12, 13, and 14 should not be rejected.

4. Claims 15, 16, 17, and 18 stand rejected as apparatus claims that correspond directly to method claims 1, 5, 6 and 7 respectively, and therefore, are rejected under the same rationale. Applicants respectfully propose that the Examiner does not establish *prima facie* obviousness for claims 1, 5, 6 and 7, and therefore corresponding apparatus claims 15, 16, 17, and 18 should not be rejected.

5. Claims 25, 26, 27, 28, 29, and 30 stand rejected as apparatus claims that correspond directly to method claims 19, 20, 21, 22, 23, and 24 respectively, and therefore, are rejected under the same rationale. Applicants respectfully propose that the Examiner does not establish *prima facie* obviousness for claims 19, 20, 21, 22, 23, and 24, and therefore corresponding apparatus claims 25, 26, 27, 28, 29, and 30 should not be rejected.

6. Claims 31, 32, 33, 34, and 35 stand rejected as apparatus claims that correspond directly to method claims 19, 21, 22, 23, and 24 respectively, and therefore, are rejected under the same rationale. Applicants respectfully propose that the Examiner does not establish *prima facie* obviousness for claims 31, 32, 33, 34, and 35, and therefore corresponding apparatus claims 31, 32, 33, 34, and 35 should not be rejected.

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obviousness for claims 19, 21, 22, 23, and 24, and therefore corresponding apparatus claims 31, 32, 33, 34, and 35 should not be rejected.

*Conclusion*

In view of the foregoing, Applicants respectfully request the allowance of all pending claims. In addition to Applicants' request for a preliminary telephone interview, if the Examiner feels that the pending claims could be allowed with minor changes, the Examiner is invited to telephone the undersigned to discuss an Examiner's Amendment.

The Commissioner is hereby authorized to charge or credit Deposit Account No. 09-0447 for any fees required or overpaid.

Respectfully submitted,



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